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EXAMINER

GOODWIN, JEANNE M

ART UNIT

PAPER NUMBER

2833

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DELIVERY MODE

04/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,817	<b>Applicant(s)</b> STALDER ET AL.	
	<b>Examiner</b> Jeanne-Marguerite Goodwin	<b>Art Unit</b> 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-10,12 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10,12 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 23 is finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, “wherein the identification element is adapted to solely be supplied with energy by induction.”

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

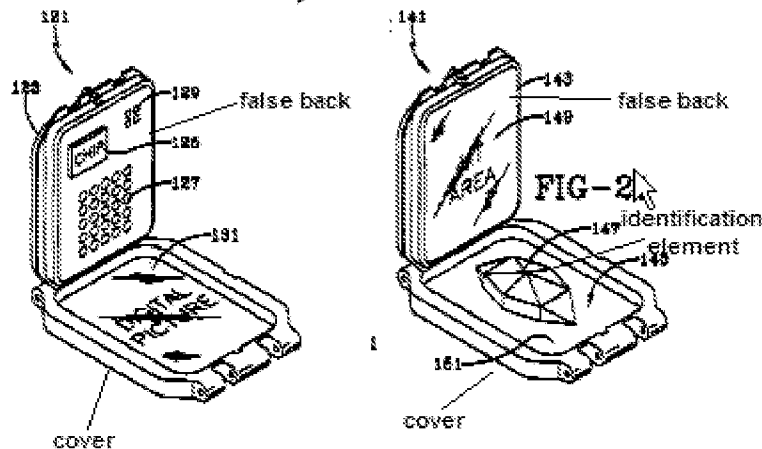
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 17 and 18 are finally rejected under 35 U.S.C. 102(e) as being anticipated by US 6618328 to Ellner.

**Regarding claim 1:** Ellner discloses a back of a watch case (Figs. 20 and 21) comprising a cover (see figures below) that defines the external surface of the back,

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characterized by a false back (see figures below) installed against the internal surface of said cover (see figures below), wherein an identification element (125 or 147) is installed between said cover and said false back (see figures below).



**With respect to the method claim 17:** the method steps will be met during the normal assembly of the apparatus stated above.

**Regarding claim 2:** Ellner discloses the back of a watch case according to the claim 1, wherein said false back (see figures above) comprises a decoration/speaker (127).

**Regarding claim 3:** Ellner discloses the back of a watch case according to claim 2, wherein said decoration (127) appears to be marked in the thickness of said false back (see figures above).

**Regarding claim 4:** Ellner discloses the back of a watch case according to claim 1, wherein said false back (see figures above) appears to have an even thickness and wherein said cover (see figures above) comprises means of attachment (75) (Figs. 12 and 13) to the middle (see figures above) of the watch case.

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**Regarding claim 5:** Ellner discloses the back of a watch case according to claim 1, wherein said false back (see figures above) is attached securely against said internal surface of said cover (Fig. 12 and 13).

**Regarding claim 18:** Ellner discloses the back of a watch case according to claim 1, wherein the identification element (125 or 147) comprises an electronic circuit (see figure above).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner in view of US 6751164 to Sekiguchi.

**Regarding claims 16 and 19:** Ellner further teaches that the identification element/ functional element (147) could be used to indicate the whereabouts of the watch assembly or of the wearer of the watch assembly. Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claims 16 and 19, i.e., wherein the identification element comprising an antenna. Sekiguchi teaches using a sensor means (79) comprising an antenna for a GPS system for recognizing location information. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the electronic circuit, as taught by

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Ellner, with the sensor means/electronic circuit, as taught by Sekiguchi, since both are alternative types of electronic devices which will provide the same function, if one is replaced with other, generating location information, respectively.

7. Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner and Sekiguchi as applied to claim 16 above, and further in view of US 46657922 to Sato.

**Regarding claim 8:** Ellner and Sekiguchi disclose a device as stated above with regards to claim 16. Ellner and Sekiguchi disclose all the subject matter claimed by applicant with the exception of the limitation stated in claim 8, i.e., wherein an electronic circuit is fixed in a cavity by way of a double-sided adhesive. Sato discloses an electronic circuit/antenna (4) being fixed in a cavity (12) by way of a double-sided adhesive (13) (col. 3, lines 5-11). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the double-sided adhesive, as taught by Sato, to the electronic circuit, in order to for the electronic circuit to be securely set in the case.

8. Claims 9 and 22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner, Sekiguchi and Sato as applied to claims 8 and 16 above, and further in view of US 4348751 to Kosaka et al. [hereinafter Kosaka].

**Regarding claims 9 and 22:** Ellner, Sekiguchi and Sato disclose a device as stated above with regards to claims 1 and 16, respectively. Ellner, Sekiguchi and Sato disclose all the subject matter claimed by applicant with the exception of the limitation

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stated in claims 9 and 22, i.e., wherein an electronic circuit is coated with a resin. Kosaka discloses using a resin on the an integrated circuit (IC) (col., 3, lines 15-33). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the resin of Kosaka, to the electronic device, as taught by Sekiguchi, in order provide moisture proof, sock resistance, chemical stability, etc., as already suggested by Kosaka (col., 3, lines 15-17).

9. Claim 10 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner.

**Regarding claim 10:** Ellner discloses a device as stated above with regards to claim 1. Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 10, i.e., the cover and/or the false back made of metal. The particular material used to make the cover and/or false back, absent any criticality, is only considered to be the use of “optimum” or “preferred” materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide a metal material, as claimed by Applicant, for the cover and/or false back of Ellner since it has been held to be a matter of obvious design choice and within the general skill of worker in the art to select a known material on the basis of its suitability for the intended use of the invention.

10. Claim 12 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner in view of US 5696741 to Nussbaum and US 6491424 to Tardy.

**Regarding claim 12:** Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 12, i.e., a process of production of the back of a watch case, comprising the following step: installation of a false back against the internal surface of the cover of the back, comprising, moreover, a prior step of stamping of said false back from a plate of even thickness, and performing a prior step of engraving of a decoration on one surface of said plate. Nussbaum discloses the process of fastening a container/false back (20) with the back cover (2c) by the process of stamping. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the process of production of the back cover/false back assembly by stamping, as taught by Nussbaum, to the process of production of Ellner, in order to reduce manufacturing costs, as already suggested by Nussbaum (col., 4, lines 40-46). Tardy discloses the process of engraving a decoration on a surface. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the process of production of engraving of a decoration, as taught by Tardy, to the process of production of Ellner, in order create a personalized message.

11. Claim 20 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner in view of Sekiguchi and US 2988868 to Lavet et al. [Lavet].

**Regarding claim 20:** Ellner further teaches that the identification element/functional element (147) could be used to indicate the whereabouts of the watch assembly or of the wearer of the watch assembly. Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 20, i.e., wherein



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the identification element comprising an antenna. Sekiguchi teaches using a sensor means (79) comprising an antenna for a GPS system for recognizing location information. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the electronic circuit, as taught by Ellner, with the sensor means/electronic circuit, as taught by Sekiguchi, since both are alternative types of electronic devices which will provide the same function, if one is replaced with other, generating location information, respectively.

Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 20, i.e., the antenna comprises a coil of wound copper wire connected by bonding directly to lugs of the electronic circuit. Lavet teaches using coils (29) and (30) being made of copper wires forming numerous convolutions or turns wound over forms or bobbins of molded insulating material (31) and (32) provided with securing lugs (col. 3, lines 65-72). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the antenna assembly of Ellner and Sekiguchi, with the antenna assembly, as taught by Lavet, in order provide an easy matter to mount, as already suggested by Lavet.

12. Claims 21 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner.

**Regarding claim 21:** Ellner discloses all the subject matter claimed by applicant with the exception of the limitation stated in claim 21, i.e., wherein the cover has a thickness of about 5 to 7 tenths of a millimeter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the thickness

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of the cover, since it has been held that discovering an "optimum value" of a result effective variable involves only routine skill in the art. See *In re Boesch* 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

13. Applicant's arguments filed Jan. 17, 2008 have been fully considered but they are not persuasive.

- **Regarding arguments on page 9, lines 1-17:** In response to Applicant's argument that prior art, Ellner do not include certain features of Applicant's invention, the limitations on which the Applicant relies, i.e., *"that the identification element is an electronic identification element called also a "transponder" composed only of an integrated circuit and a coil. This identification element is completely isolated from the rest of the watch and hidden between the false back and the cover. It can only communicate with the external world by radio frequency via the coil and when excited by an external reader,"* are not stated in claim 1. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. See *Constant v. Advance Micro-Devices Inc.*, 7 USPQ2d 1064. Furthermore, limitations from specification not relied upon since it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not

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be relied upon to impart patentability to an otherwise unpatentable claim. See *In re Lundberg*, 113 USPQ 530 (CCPA 1957).

- **Regarding argument on page 10, lines 1-5:** With respect to Ellner disclosing a “functional member 147” that can emit sound aroma, contrary to Applicant's belief, the sound aroma serves as an identification means, in a broad sense it is identifying a particular sound aroma. In response to Applicant's argument that prior art, Ellner do not include certain features of Applicant's invention, the limitation on which the Applicant relies, i.e., “*a hidden compartment and its false back*,” is not stated in claim 1. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. See *Constant v. Advance Micro-Devices Inc.*, 7 USPQ2d 1064. Furthermore, limitations from specification not relied upon since it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim. See *In re Lundberg*, 113 USPQ 530 (CCPA 1957).

- **Regarding argument on page 10, lines 6-12:** With respect to Ellner disclosing a “a decoration, e.g., speaker”, contrary to Applicant's belief, the speaker, in a broad sense it is a decorative element. In response to Applicant's argument that prior art, Ellner do not include certain features of Applicant's invention, the limitation on which the Applicant relies, i.e., “*The technique of decoration is a kind of metal surface treatment*,” is not stated in claim 2. It is the claims that define the claimed invention, and it is claims,

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not specifications that are anticipated or unpatentable. See *Constant v. Advance Micro-Devices Inc.*, 7 USPQ2d 1064. Furthermore, limitations from specification not relied upon since it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim. See *In re Lundberg*, 113 USPQ 530 (CCPA 1957).

- **Regarding argument on page 10, lines 13-15:** With respect to the argument that the prior art, Ellner's attachment means of the false back and the cover to the middle are completely different, it does not negate the fact that Ellner still discloses an attachment means.
- **Regarding argument on page 10, lines 14-24:** With respect to the combination of Ellner and Sekiguchi disclosing a “an electronic identification element comprises an electronic circuit and an antenna”, contrary to Applicant's belief, the combination of Ellner and Sekiguchi do have an electronic identification element comprising an electronic circuit and an antenna. In response to Applicant's argument that prior art, Ellner and Sekiguchi does not include certain features of Applicant's invention, the limitation on which the Applicant relies, i.e., “*an electronic identification element called also a “transponder” composed only of an integrated circuit and a coil. This kind of transponder is passive because it is not supplied by a battery. The integrated circuit is a specific circuit dedicated for the identification's application,*” is not stated in claim 16. It

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is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. See *Constant v. Advance Micro-Devices Inc.*, 7 USPQ2d 1064. Furthermore, limitations from specification not relied upon since it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim. See *In re Lundberg*, 113 USPQ 530 (CCPA 1957).

- **Regarding argument on page 11, lines 1-5:** In response to Applicant's argument that prior art, Ellner do not include certain features of Applicant's invention, the limitations on which the Applicant relies, i.e., "*the identification element is a memory and contains the information of the watch. It allows, for example, to fight against falsification,*" are not stated in the claim. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. See *Constant v. Advance Micro-Devices Inc.*, 7 USPQ2d 1064. Furthermore, limitations from specification not relied upon since it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim. See *In re Lundberg*, 113 USPQ 530 (CCPA 1957).

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- **Regarding argument on page 11, lines 6-13:** In response to Applicant's argument that *"it is well-known that it is very difficult to read the information contained in the transponder when it is encapsulated in a metal case, for example, composed of a false back and the cover. The reason is that the metal strongly attenuates the transmission of radio frequency. A person having ordinary skill and creativity would thus fail to design an identification element working with a false back and a metallic cover,"* contrary to Applicant's, JP 2002250783A to Paratte et al. discloses a transponder including an antenna in a metal case (Abstract).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 2002250783A to Paratte et al. discloses a transponder including an antenna in a metal case.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Jeanne-Marguerite Goodwin whose telephone number is (571) 272-2104. The examiner can normally be reached on Monday-Friday (9am-6pm), alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on (571) 272-2009. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2861.

/Jeanne-Marguerite Goodwin/  
Examiner, Art Unit 2833  
April 14, 2008

*/renee luebke/*

Acting SPE  
AU 2833